

Attorney Docket Number: P33099USw

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application: A. Eatherton, et al.

Serial No.: 10/524,470

Examiner: Rao, D.

Filing Date: February 28, 2006

Art Unit: 1624

For: PYRIMIDINE DERIVATIVES AND THEIR USE AS CB2 MODULATORS

Mail Stop Petition  
Commissioner for Patents  
P.O. BOX 1450  
Alexandria, Va. 22313-1450

**REQUEST FOR RECONSIDERATION OF PATENT TERM UNDER**  
**35 USC 154(b) and 37 CFR §1.705(d)**

This is a request for reconsideration of patent term adjustment pursuant to 37 CFR §1.705(d), according to which the applicant may request reconsideration within two months from the date the patent issued if the patent indicates or should have indicated a revised patent term adjustment. Applicant respectfully seeks **300** days of patent term adjustment in addition to the **550** days stated on the Issue Notification for a total of **850** days. Accompanying this request is the required processing fee set forth in 37 CFR § 1.18(e). The statement of facts supporting this request is set forth below pursuant to 37 CFR §1.705(b)(2). Note, the issues raised herein under 37 CFR 1.703(b)/1.705(a) could not have been raised prior to payment of the issue fee because the total term eligible for extension could not have been calculated until actual issuance of the patent by the USPTO.

**Statement of Relevant Facts/Dates:**

There are several dates relevant to the calculation of patent term adjustment. Those dates are summarized below:

30-month date for Application: February 21, 2005

Date of Completion of 35 USC 371 Requirements: February 28, 2006

3-year Pendency ended: February 21, 2008

35 USC 154(b)(1)(B) "3-year" PTA began: February 22, 2008

First office action mailing Date: October 6, 2008

Response to First Office Action (to satisfaction of the Office): May 5, 2009

Issue date: December 22, 2009

**Patent Term Adjustment Under 35 USC 154**

35 USC 154(b)(1) governs patent term guarantees – patent term adjustments available to compensate for delays in prosecution due to USPTO delay. 35 USC(b)(1) has two main sections. 35 USC 154(b)(1)(A) governs situations that arise under the "14-4-4-4 Rule", where delay occurs for failure of the Office to issue a first action within 14 months from filing of the application, or within 4 months after various applicant responses. Delay under this subsection is referred to as "A delay". 35 USC 154(b)(1)(B) governs situations under which pendency of the application exceeds 3 years from filing due to USPTO delay. Delay under this subsection is referred to as "B delay".

**Patent Term Adjustment due under "A delay" is 527 days**

Under 35 U.S.C. § 154(b)(1)(A), the applicant is guaranteed prompt USPTO responses. If the issue of an original patent is delayed due to failure of the Office to engage in reasonable efforts to conclude prosecution, the term of the patent shall be extended in accordance with 37 CFR § 1.703(a).

In this application, the Office failed to issue an office action within 14 months from the completion of requirements under 35 USC 371, as required by 35 USC 154(b)(1)(A)(i). In fact, the Office did not issue an office action until 527 days after the 14-month time limit had passed. **527 days** was the total A delay on behalf of the Office.

**Patent Term Adjustment due under "B delay" is 669**

Under 35 U.S.C. § 154(b)(1)(B), the Applicant is guaranteed of no more than a 3-year application pendency. If the issuance of a patent is delayed beyond 3 years due to USPTO delay, then the term of the patent shall be extended in accordance with 37 CFR § 1.703(b). The

term of a patent shall be extended 1 day for each day of Office delay after the end of the 3-year period until the patent is issued, not including any delay in the processing of the application requested by the applicant.

According to 35 USC 154(b)(1)(b), B delay begins to accumulate 3 years after the application was actually filed. 37 CFR 1.702 interprets "actually filed" as the commencement of a 35 USC 371 national stage under either 35 USC 371 (b) or (f). The 30-month date for this application was February 21, 2005.

Per 37 CFR 1.703(b), the B delay is calculated from the day after the three year period ended, i.e. February 22, 2008, and ending on the date the patent issued, December 22, 2009, which is calculated to be 669 days. There was no Applicant delay associated with the B delay, so the total B delay was **669 days**.

Applicant Delay is 119 days

According to 35 USC 154(b)(2)(c), the period of adjustment shall be reduced for that period of time over 3 months that an Applicant fails to respond to a notice of rejection. In this application, the Applicant delayed 55 days after the three month deadline for response to the first office action. Additionally, the Office indicates that the Applicant delayed 64 additional days after the 3-month deadline for response to the first office action while responding to a notice of non-compliant amendment. Total Applicant delay allocated to Applicant is 119 days.

Overlapping period and total patent term adjustment

According to § 1.703(f), the term of a patent is entitled to adjustment under § 1.702 and the term shall be adjusted for the sum of the periods calculated under paragraphs (a) through (e), to the extent that such periods are not overlapping, less the sum of the periods calculated under § 1.704.

The subject of overlap has been addressed in Wyeth v. Kappos, where the Court of Appeals for the Federal Circuit held that the only way periods of time can "overlap" is if the A and B delays occur on the same day, and that the B delay begins when the PTO has failed to issue a patent within three years, not before.<sup>1</sup>

Here, the overlap period occurs beginning on the day after three years of pendency (February 22, 2008) and ending on the date that the first office action was mailed (October 6, 2008). This **227 days** overlap period should be subtracted from the Patent Term Adjustment.

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<sup>1</sup> Wyeth v. Dudas, 580 F. Supp. 2d 138, 142, affirmed by CAFC as Weyth v. Kappos (January 7, 2010).

Calculation of Patent Term Adjustment

Applicants contend that the total patent term adjustment the above patent is entitled to, as explained herein, should be **850 days** (527 days of A delay + 669 days of B delay – 199 days of Applicant delay – 227 days of overlap).

Conclusion

Applicants submit that in view of the foregoing, the subject patent is entitled to a total of **850 days** of patent term adjustment, which would be an additional 300 days of adjustment beyond the 550 days stated on the issue notification. Applicant hereby respectfully request reconsideration of the patent term adjustment.

If a telephone conference would help the Office determine this matter, the Office is encouraged to call the undersigned attorney. If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge any fees or credit any overpayment, particularly including any fees required under 37 CFR Sect 1.18, and any necessary extension of time fees, to deposit Account No. 07-1392.

Respectfully submitted,



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Date: Feb 15 2010  
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